IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

QUAD INT'L, INCORPORATED,

Opposer,

vs.

ANDREA FISCHER,

Applicant.

Opposition No.: 91160119

Serial No.: 76/516972

Mark: CHLOE VEVRIER

Published: March 23, 2004

TTAB

CERTIFICATE OF MAILING

I hereby certify that on **June 13, 2005**, this paper is being deposited with the U.S. Postal Service by "Express Mail Post Office to Addressee" service with Express Mail Label No. 181516, for delivery to the United States Patent and Trademark Office, Madison Building, 600 Dulany Street, Alexandria, VA 22313.

LAURA GANOZA

OPPOSER'S RESPONSE IN OPPOSITION TO APPLICANT'S CROSS MOTION FOR SUMMARY JUDGMENT

Opposer, Quad Int'l Incorporated, ("Opposer") by and through its undersigned counsel, hereby files its response in opposition to Applicant's Cross-Motion for Summary Judgment. For the reasons set forth below, Applicant's Motion for Summary Judgment must be denied.

INTRODUCTION

Applicant seeks summary dismissal of this opposition proceeding based on two equally frivolous grounds: 1) Opposer is estopped from pursuing this opposition due to delay and/or acquiescence and 2) Opposer has failed to demonstrate that its mark CHLOESWORLD is confusingly similar to the name CHLOE VEVRIER (the "Challenged Trademark"). Applicant's estoppel argument has no basis in law or in fact, and must be rejected. Similarly, as a matter of law, Applicant has not remotely satisfied her burden with respect to the lack of likelihood of

confusion. This issue is appropriate for disposition at trial, rather than at this juncture. For these reasons, Applicant's cross motion for summary judgment must be denied in its entirety.

ARGUMENT

I. OPPOSER IS NOT ESTOPPED FROM PURSUING THIS OPPOSITION.

A. Applicant's Laches Defense is Impermissible As A Matter of Law.

Applicant claims that since Opposer asserted "no claims whatsoever prior to filing the Notice of Opposition," it is thus barred from pursuing this opposition. To the extent this defense is based on the laches, it is clear that Applicant is precluded from asserting this defense, as a matter of law. The Court's decision in *Nat'l Cable Television Ass'n v, Am. Cinema Editors, Inc.*, 937 F.2d 1572, 19 U.S.P.Q.2d 1424 (Fed. Cir. 1991), clarified this issue. Indeed, in the event a party protests the issuance of a registration, laches cannot start to run prior to the date the mark is published for opposition. *See also DAK Indus. Inc. v. Daiichi Kosho Co. Ltd.,* 25 U.S.P.Q.2d 1622 (TTAB 1993) (holding that in an opposition proceeding, laches cannot begin to run until the mark is published for opposition).

In the instant case, the mark was published for opposition on March 23, 2004. This is the period to consider when determining if the defense of laches applies. A mere 15 days later, on April 7, 2005, even before the 30-day opposition period had expired, Opposer filed this opposition. Given this chronology, Applicant's defense based on laches is clearly inapplicable and fails. Accordingly, as a matter of law, Applicant's motion for summary judgment predicated upon this ground should be denied.

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B. Applicant's Defense of Estoppel and/or Acquiescence Is Legally and Factually Unsupportable.

Applicant asserts that Opposer is estopped from obtaining relief in this opposition because it has somehow "followed a course of conduct and made specific representations acknowledging Applicant's use and ownership of the name CHLOE VEVRIER for the rendition of her professional services." To the extent that Applicant seeks entry of summary judgment on the affirmative defenses of acquiescence and estoppel, it is well settled that "[a]cquiescence and estoppel require some affirmative act by opposer which led applicant to reasonably believe that opposer would not oppose applicant's registration of its mark." *DAK Indus. Inc.,* 25 U.S.P.Q.2d at 1625. Acquiescence requires proof of three elements: (1) that opposer actively represented that it would not assert a right or a claim; (2) that the delay between the active representation and assertion of the right or claim was not excusable; and (3) that the delay caused applicant undue prejudice. *Coach House Restaurant, Inc. v. Coach And Six Restaurants, Inc.*, 934 F.2d 1551, 1564, 19 U.S.P.Q.2d 1401, 1409. (11th Cir. 1991). The elements of equitable estoppel are similar and require: (1) misleading conduct which leads another to reasonably infer that rights will not be asserted against it; (2) reliance upon this conduct; and (3) due to this reliance, material prejudice if the delayed assertion of such rights is permitted. *Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc.*, 971 F.2d 732, 23 U.S.P.Q.2d 1701 (Fed. Cir. 1992). In the instant case, Applicant has not, and cannot, prove the foregoing elements.

1. Applicant fails to prove the required "affirmative conduct" to establish these defenses.

Applicant bases her defenses on the assertion that "since May 30, 1992 until the date on which it filed its Notice of Opposition," Opposer failed to assert any rights in the name and engaged in affirmative conduct that confirmed Applicant's exclusive use and ownership of the

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mark. Since acquiescence and estoppel both require an affirmative act by Opposer, Applicant's claim that Opposer "failed to assert any rights" is insufficient as a matter of law. Without proving any affirmative conduct, Applicant has no legal basis for this defense.

Aside from the legal insufficiency, this claim is also factually deficient. Applicant failed to assert any exclusive rights in the name CHLOE VEVRIER until she filed her initial trademark application in November of 1992, denoted as Serial No. 76467272.[1] Prior to that time, Opposer had no basis to challenge Applicant's claims to exclusive ownership of the Challenged Trademark, *because Applicant had made none.*[2] In the decade preceding this filing, Applicant never attempted to file a trademark application wherein she asserted exclusive rights to the Challenged Trademark. Even after her filing, however, Applicant failed to assert exclusive rights. In fact, after the Trademark Examiner determined that Applicant could not register the mark because it did not function as a trademark, Applicant expressly abandoned this application. Given Applicant's conduct in failing to attempt to register the Challenged Trademark for more than a decade, Opposer could not be accused of estoppel or acquiescence.

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[1] It should be noted that Opposer specifically requested that Applicant produce documents relating to any trademark application filed by Applicant for the Challenged Trademark. *See* Exhibit G to Opposer's Brief in Support of Summary Judgment, RFP # 4. Although Applicant had filed an application prior to the one at issue in this proceeding, she failed to inform Opposer of this fact, and further failed to produce any documents in relation to this prior application. Opposer had to use its own efforts to become aware of this prior application, and its refusal by the Trademark Examiner. This is just another example of the type of evasive discovery tactics Applicant has employed throughout this proceeding. For other examples, Opposer directs the Board to its previously filed Motion for Sanctions.

[2] Applicant urges that the October 1, 2000 Agreement is evidence of her claimed ownership of the Challenged Trademark. Applicant asserts that the Agreement does not contain any specific reference or inference that Opposer owns any rights in the name. However, it is equally important that this Agreement does not contain any specific reference or inference that *Applicant* owns any rights in the name. Instead, it indicates Opposer is the only entity with full control over the use of this moniker in the Internet. The language in this Agreement clearly favors Opposer, not Applicant.

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In addition, when Applicant eventually filed the application that is the subject of this proceeding in May of 2003, Applicant claimed a first use date of March 20, 2003. Unlike now, Applicant did not claim that she had been using the mark exclusively since 1992. Instead, her application claimed that she just recently begun to use the Challenged Trademark. Again, given Applicant's sworn statements in the application, Opposer had no basis for believing Applicant would assert that her use pre-dated Opposer's.

Notwithstanding these inherent contradictions, once as soon as Opposer became aware of this new filing, Opposer immediately notified Applicant that it would oppose her registration. *See* Declaration of Lawrence Iyoho, Director of Operations, attached hereto as Exhibit "A." Indeed, on January 22, 2004, Opposer specifically advised Applicant that it "intends to file an opposition to your trademark application for the mark 'Chloe Vevrier' in Class 41." *See* Exhibit 1, to Declaration of Lawrence Iyoho.[3] Based on all the foregoing, Applicant has no factual basis for asserting that Opposer failed to challenge her use and ownership of the Challenged Trademark.

The notion espoused by Applicant that Opposer "engaged in affirmative conduct" that confirmed Applicant's exclusive use and ownership of the Challenged Trademark is wholly without merit. Indeed, Applicant failed to establish the lack of genuine issues as to whether Opposer actively represented it would not assert the instant claim. Although Applicant plead that Opposer made "specific representations," these representations are completely absent from her motion. As set forth above, factual evidence directly contradicts this assertion. Applicant's claim that Opposer's conduct in removing the "Official" notation from its website is equally specious. The sole reason for this action was because the exclusive agreement between the parties had

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expired, not because Opposer believed Applicant was the exclusive owner of the name. If that was the case, Opposer would have removed its CHLOESWORLD website entirely, and deleted all references to the name CHLOE VEVRIER in its marketing and promotional materials. Clearly, Opposer did not do so, and Applicant simply cannot point to any "affirmative conduct" establishing estoppel.

2. Applicant fails to establish prejudice and undue delay.

Applicant has presented no evidence whatsoever that she has suffered any prejudice due to the purported delay in bringing the present opposition. As set forth above, she is the individual who delayed in seeking a registration in the first place. In addition, even before the mark was published, she was warned that her application would be opposed. *See* Exhibit 1, to Declaration of Lawrence Iyoho. Finally, Applicant failed to establish that any delay on the part of Opposer was unreasonable. As detailed above, Opposer filed this opposition proceeding as soon as it was legally permissible to do so.

Accordingly, Applicant cannot establish that there are no genuine issues of material fact and that she is entitled to judgment on the defenses of acquiescence and estoppel. In particular, Applicant has not established the lack of genuine issues as to whether opposer actively represented it would not assert the present claim before us, whether Applicant has suffered any prejudice due to the delay in bringing the present opposition proceeding, and whether Opposer's delay was not excusable. In view of the foregoing, Applicant's cross-motion for summary judgment should be denied.

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[3] Please note that this document was not produced in discovery because it was not requested by Applicant.

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II. THE RELEVANT MARKS ARE CONFUSINGLY SIMILAR.

The relevant factors in a likelihood of confusion analysis are set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). The following factors are usually the most relevant: (i) the similarity or dissimilarity of the marks as to appearance, sound, connotation and commercial impression; (ii) the relatedness of the goods or services as described in an application or registration or in connection with which a prior mark is in use; (iii) the similarity or dissimilarity of established, likely-to-continue trade channels; and (iv) the conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing. In addition, the advertising media used and evidence of actual confusion are additional factors that may be considered. Ignoring the vast majority of these factors, Applicant conveniently focuses on just two of these factors.[4] When the Board considers each of the foregoing factors, it is clear that Applicant has not shown that there is no likelihood of confusion as a matter of law.

A, The Marks Not Only Similar, They Are Used On Identical Services.

Applicant does not, and cannot, dispute that the mark CHLOESWORLD and CHLOE VEVRIER are used with identical services. Both are used in connection with entertainment services on the Internet. In addition, both are used in connection with the marketing of videos/DVD's and in magazines. "When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *In re Kent-Gamebore Corp*, 59 U.S.P.Q.2D 1373 (TTAB 2001) (citing *Century 21 Real Estate*

[4] Applicant also focuses solely on Opposer's allegation that the Challenged Mark is likely to be confused with CHLOESWORLD. Applicant's motion does not take any issue with the allegations in Opposer's Notice of Opposition that her use of the Challenged Mark is likely to be confused with Opposer's own use of the identical mark, CHLOE VEVRIER, which Opposer has been using since 1992. Accordingly, Opposer need not address this issue at this time.

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Corp. v. Century Life of America, 970 F.2d 874, 23 U.S.P.Q.2d 1698, 1700 (Fed. Cir. 1992). Applicant ignores this legal tenet, and merely argues that a side-by-side comparison of the marks indicates that the marks sound and look dissimilar. Applicant applies the wrong test.

The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *See In re Thomas H. Wilson*, 57 U.S.P.Q.2d 1863 (TTAB 2001) (citing *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975)). "Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark." *Id.* (citing *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985)).

Upon application of the correct test, it is clear that the marks are sufficiently similar under *du Pont*. Specifically, the marks look and sound alike due to the shared word CHLOE, clearly the dominant term in both marks. *See Century 21 Real Estate Corp.* 970 F.2d 874, 23 U.S.P.Q.2d 1698, 1700 (refusing registration when both marks used the dominant term "Century"). In addition, both marks project the same connotation, with both marks suggesting a rather sultry, sexy female name. Given the identical goods and services, and the similar sound and connotations, Applicant cannot establish, as a matter of law, that the marks are not likely to be confused. Even if purchasers note the differences in the marks, they are likely to believe that Applicant's mark is related to Opposer's mark. Applicant herself believes this is the case since she uses a disclaimer on her own website to advise visitors she is not affiliated with Opposer. *See* Exhibit O to Opposer's Brief, Applicant's website.

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B. The Trade Channels, Customers and Advertising Media Are Identical.

In an apparent effort to avoid the obvious consequence of her flawed legal reasoning, Applicant completely ignores important *du Pont* factors in her motion -- the similarity of the trade channels, advertising outlets, and consumers. "Obviously, identical goods would travel through all the same channels of trade to all the usual purchasers." *In re Kent-Gamebore Corp*, 59 U.S.P.Q.2D 1373.

In this case, it is undisputed that both Applicant and Opposer advertise and sell their wares on the Internet, and in adult publications. In addition, their consumers are similar. The make up of consumers are Internet website users, and purveyors of adult materials. Applicant has not presented any evidence that the consumers at issue in this case are sophisticated. Whereas sophisticated consumers may be expected to exercise greater care, *see e.g.*, *Electronic Design & Sales v. Electronic Data Systems*, 954 F.2d 713, 718, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992), impulse buyers, such as the ones purchasing these services, are not expected to exercise such care. Accordingly, confusion is much more likely in this instance, and Applicant has not established otherwise.

C. There Has Been Evidence of Actual Confusion.

Applicant makes the bold assertion that "there is not a single known instance of anyone confusing or otherwise believing the serviced of Applicant designated by the CHLOE VEVRIER service mark were produced, sponsored or endorsed by Applicant". This statement is false. As Opposer advised Applicant in discovery, there has been at least one instance of actual confusion since Applicant launched her website. As Opposer advised Applicant in response to Interrogatory No. 8 of Applicant's First Set of Interrogatories, on or about April 1, 2004, one of Opposer's website advertising agents went to Applicant's website, www.chloevevrier.com,

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mistakenly believing this website was affiliated with Opposer and downloaded pictures contained in the website. For advertising purposes, Opposer authorizes its agents to download images from Opposer's websites to be used in promotional materials. Believing the images belonged to Opposer, the agent began using these images under the URL http://top-sex.info/06/047/ to promote Opposer's www.chloesworld.com website. Opposer's agent believed that these two sites were affiliated due to Opposer's long-standing use and promotion of the name CHLOE VEVRIER. *See* Exhibit F to Opposer's Brief; *see also* Declaration of Lawrence Iyoho, ¶ 9.

This instance of actual confusion is highly probative of likelihood of confusion between the two marks. With this evidence alone, Applicant's motion must be denied. This evidence, compounded with the similarities in the appearance, commercial impression, goods and services offered, trade channels, customers and advertising media, establishes an even greater reason to believe that the marks are likely to be confused. Accordingly, Applicant's motion must be denied.

CONCLUSION

For all these reasons, Applicant's cross motion for summary judgment must be denied in its entirety.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing RESPONSE IN OPPOSITION TO APPLICANT'S CROSS MOTION FOR SUMMARY JUDGMENT was served this 13th day of June, by mailing by first class mail, postage prepaid, on the attorney named below:

Michael A. Painter, Esq.
Isaacman, Kaufman & Painter
8484 Wilshire Boulevard, Suite 850
Beverly Hills, California 90211

Attorney

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

QUAD INT'L, INCORPORATED,	:	**Opposition No.: 91160119**
Opposer,	:	**Serial No.:** 76/516972
vs.	:	**Mark:** CHLOE VEVRIER
ANDREA FISCHER,	:	**Published:** March 23, 2004
Applicant.	:	

DECLARATION OF LAWRENCE IYOHO PURSUANT TO 37 C.F.R. SECTION 2.20 IN SUPPORT OF OPPOSER'S MOTION FOR SUMMARY JUDGMENT

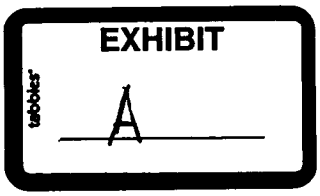
1. My name is Lawrence Iyoho. I am a resident of the State of Florida and am otherwise *sui juris.*

2. I am the Director of Operations for Quad Int'l Incorporated d/b/a The SCORE Group (the "Opposer"). I have personal knowledge of the matters set forth in this Declaration and have been authorized by Opposer to submit this Declaration.

3. As Director of Operations, I am responsible for, among other things, overseeing Opposer's trademarks and intellectual property. It is a regular business practice of Opposer's for me to be copied on correspondence regarding these matters.

4. On January 22, 2004, I was copied on an e-mail correspondence from Opposer's in-house counsel to Applicant wherein Applicant was advised that Opposer would be filing an opposition to her trademark application for CHLOE VEVRIER. A true and correct copy of this e-mail correspondence is attached hereto as Exhibit 1.

5. At no time did Opposer ever advise Applicant that it would not be asserting any rights to the name CHLOE VEVRIER.



6. Instead, at all times material hereto, Opposer attempted to protect its rights with respect to the name CHLOE VEVRIER.

7. Unlike Applicant contends, there was at least one instance of actual confusion between the Applicant's services offered under CHLOE VEVRIER, and Opposer's services offered under CHLOESWORLD.

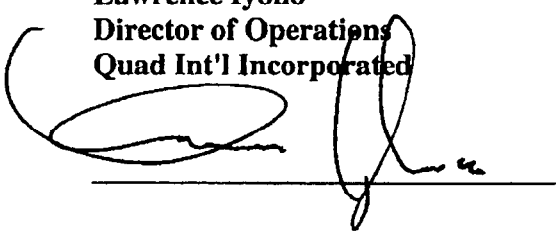
8. On or about April 1, 2004, one of Opposer's website advertising agents went to Applicant's website, www.chloevevrier.com, mistakenly believing this website was affiliated with Opposer and downloaded pictures contained in the website. For advertising purposes, Opposer authorizes its agents to download images from Opposer's websites to be used in promotional materials. Believing the images belonged to Opposer, the agent began using these images under the URL http://top-sex.info/06/047/ to promote Opposer's www.chloesworld.com website.

9. Opposer's agent believed that these two sites were affiliated, and became confused due to Opposer's long-standing use and promotion of the name CHLOE VEVRIER.

10. I, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of the opposition proceeding herein, declare that the facts set forth in this declaration are true; all statements made of my own knowledge are true; and all statements made on information and belief are believed to be true.

Date: June 13, 2005

Lawrence Iyoho
Director of Operations
Quad Int'l Incorporated



-----Original Message-----
From: Mike Uwate [mailto:uwatem@scoregroup.com]
Sent: Thursday, January 22, 2004 3:53 PM
To: chloe@chloevevrier.com; info@chloevevrier.com
Cc: John C. Fox; Lawrence Iyoho
Subject: Trademark Filing

TO: Andrea Fischer
Jason Seifert

FROM: The SCORE Group

RE: Trademark Application Serial R: 76516972

Please be advised that The SCORE Group intends to file an opposition to your trademark application of the mark "Chloe Vevrier" in Class 41 scheduled for publication February 10, 2004.

The SCORE Group is, however, willing to discuss alternatives to litigation in the matter at hand.

If you could have your attorney and/or authorized representative contact me on or before 6:00 p.m. (EST) February 5, 2004 to discuss the matter, I'm confident an accord can be reached that would be acceptable to both parties.

I can be reached via e-mail or by voice (305-662-5959, ext. 249).

Sincerely,

Michael Uwate
General Counsel
The SCORE Group